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09/992,283	11/05/2001	Douglas F. Connor	020431.1055	7058
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i2 TECHNOLOGIES US, INC. ONE i2 PLACE, 11701 LUNA ROAD DALLAS, TX 75234			KRISCIUNAS, LINDA MARY	
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			3623	

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,283

Applicant(s)

CONNOR ET AL.

Examiner

Linda Krisciunas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-16, 19-27 and 30-35 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 17, 18, 28 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The following is a Non-Final Office Action in response to the amendments filed April 3, 2006. Claims 1-35 are pending and claims 11, 22 and 33 were amended. Claims 27 and 35 were amended for typographical errors.

Response to Amendment

2. The amendments to claims 11, 22 and 33 consist of changing a low, medium and high risk naming and referring instead to a maximum score which is a maximum attainable score. The maximum score would inherently be the maximum attainable score. There is no way to score higher than what is attainable. Figures 5a and 5b display the maximum attainable score of "always" and "1000" respectively. In addition, paragraphs 96 and 103 teach about the maximum score prior to the alert. Therefore there is a maximum score that can be attained prior to the sending of an alert. This is equivalent to maximum attainable score as it performs an identical function in substantially the same manner with substantially the same results.

Response to Arguments

3. The Examiner has fully considered the applicant's arguments with respect to the reference not anticipating every detail of the claim, most specifically with reference to the phrase "software implementation project" and it is deemed not persuasive. The Examiner asserts that the phrase "software implementation project" is intended use and does not affect the functionality of the claimed invention which teaches risk assessment and scoring and weighting various factors which can be performed with various types of projects.

In response to applicant's argument that "software implementation project", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

4. With respect to the idea of a potential weighted score, the Examiner notes paragraph 74, where an initial risk assessment score is calculated which subsequently is re-calculated as continuous-like updating of risk assessment takes place. This is interpreted to be equivalent to a potential weighted score as it performs an identical function in substantially the same manner with substantially the same results since both are scores that are updated and changed and are not the actual or final score.

5. With respect to claims 2-3, 13-14 and 24-25, the Examiner deems the argument persuasive and the rejection is withdrawn. New art has been cited for this rejection.

6. With respect to the use of Official Notice, the Examiner cites MPEP 2144.03: To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice,

the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate. (MPEP § 2144.03(C))

Applicant has not “specifically point[ed] out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.” Applicant's broad request for references to support Examiner's statements of Official Notice amounts to nothing more than an unsupported challenge. For these reasons, the Official Notice taken for claims 5, 8, 10, 16, 19, 21, 27, 30 and 32 are taken to be admitted prior art because Applicant's traversal was inadequate.

7. With respect to claims 6, 17 and 28, the Examiner deems the argument persuasive and the rejection is withdrawn. New art has been cited for this rejection.

8. With respect to claims 7, 18 and 29, the Examiner deems the argument persuasive and the rejection is withdrawn. New art has been cited for this rejection.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 4, 9, 11-12, 15, 20, 22-23, 26, 31, 33 and 33-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwartz (US 2003/0037063).

11. As per claims 1, 12, 23, and 34-35, Schwartz teaches a system for generating risk assessment regarding software implementation projects comprising (paragraph 24: “the invention is directed to a network based method and system for risk assessment, risk monitoring and caseload management” whereby the exact field that the invention is used for is not a limitation as risk assessment is applicable across a range of fields. Therefore, the phrase “software implementation project” is intended use and does not affect the functionality of the claimed invention.): access a specified importance value and maximum score for each risk factor (paragraph 96: “Decision

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block 417 represents a process where an initially assessed risk score is compared to a maximum acceptable value. If the assessed risk score does not exceed the acceptable value, no unacceptable risk is present and the system returns to standby mode (process 404). If the initial score is indicative of unacceptable risk (high risk), process 428 is performed to determine and store an initial "goal." The initial goal may be determined by a worker or generated automatically by system software 324."), the importance of each risk factor reflecting experience of an implementing entity regarding the extent to which the risk factor may negatively impact a software implementation project if the risk factor is not adequately addressed (paragraph 53: "based on weighting variables defined by experts in the field." Whereby the expert would understand the importance and would reflect the experience of the potential negative impact if the factor was not considered), the importance value and maximum score for each factor is multiplied to define a potential weighted score for each factor (paragraph 74: where an initial risk assessment score is calculated which subsequently is re-calculated as continuous-like updating of risk assessment takes place. This is interpreted to be equivalent to a potential weighted score as it performs an identical function in substantially the same manner with substantially the same results since both are scores that are updated and changed and are not the actual or final score.); receive an actual score for each factor based on an analysis by the implementing entity specific to the particular software project (paragraph 97: "Logs may include risk scores associated with the clients, flags indicating high risk, goals, and other data such as detailed information about the primary client and associated secondary clients." Whereby an actual score is calculated for each factor.);

generate an actual weighted score for each risk factor by multiplying the importance value and the actual score for the risk factor (paragraph 26: "Another aspect of the present invention is to provide a method of risk assessment where relative weights of risk assessment variables are determined and refined to produce accurate assessments."); determine a relationship between the potential weighted score and the actual weighted score for each factor (paragraph 93: "Process 401 represents a step that may be included to initiate a risk assessment application when using ANN or AFLRA based applications. Input-output data sets of known risk assessment input and expected output are first obtained. This "historical" data is then stored in database 304 during process 402. The historical data set is used to train the ANN or AFLRA software in process 403 using error backpropagation or other training algorithms known to those skilled in the art. Of course, it is to be understood that steps 401-403 are not always necessary if a fuzzy logic expert system is used alone as the risk assessment application in the present invention." Whereby the algorithm relates between the historical or potential data and the actual data); assign a risk level for the particular project to each risk factor according to the relationship between the potential weighted score and the actual weighted score for the risk factor, the risk level for each factor representing an assessment by the implementing entity regarding the extent to which the factor is not adequately addressed (paragraph 101: "When a dangerously high-risk level is assessed for a primary client, system 300 may suggest other means of notification" whereby a flag may be generated as noted in paragraph 90 to indicate the level was exceeded.); and generate a risk assessment for the project comprising one or

more of the assigned risk levels for the project for one or more corresponding risk factors (paragraph 101: "When a high-risk assessment is generated by system 300" whereby an assessment is conducted with respect to a risk level.).

As per claims 4, 15 and 26, Schwartz teaches the risk factor is associated with one of a plurality of risk factor categories, each risk factor category comprising one or more risk factors (paragraph 46: "include several risk categories for which the present invention can be used." And paragraph 59: "input variables representing risk factors").

As per claims 9, 20 and 31, Schwartz teaches the actual score for a risk factor is determined by the implementing entity and is based on an evaluation of client resources and capabilities relevant to the risk factor (paragraph 53: "Risk assessment is a complex process where decisions leading to a risk assessment score are made based on weighting variables defined by experts in the field. A composite risk score is reached by combining weighted contributions of these variables. Whether a variable is particularly relevant, or should be minimized, is usually left to the judgement of an expert in the particular field of risk being assessed. Additionally, variables under consideration when assessing risk, by their nature, are often imprecise or uncertain in the classical first order logic and classical probability theory sense. Because the number of relevant variables and determination of particular weights assigned to them present a formidable task for a system designer, known systems often produce scores that fail to adequately represent risk." Whereby the implementing entity (or seller) would be an expert and able to assign weights to lead to the calculation of the actual risk score.).

As per claims 11, 22 and 33, Schwartz teaches the maximum score is a maximum attainable score (The maximum score is inherently the maximum attainable score. A maximum score is taught in Figure 5a and 5b where they list maximum scores of "always" and 1000 respectively. In addition, paragraphs 96 and 103 teach about the maximum score prior to the alert. Therefore there is a maximum score that can be attained prior to the sending of an alert. This is equivalent to maximum attainable score as it performs an identical function in substantially the same manner with substantially the same results.).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2, 13 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (US 2003/0037063) in view of Bowman et al (US 2003/0061246).

As per claims 2, 13 and 24, Schwartz does not explicitly teach a scorecard. Bowman teaches that it is known the components generate a risk assessment scorecard for display which provides risk factors and the importance value, maximum score, potential weighted score, actual score, actual weighted score and risk level for each factor in a spreadsheet format (The listing of actual score and weighted score etc

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are viewed as different representations of the same data and are deemed a design choice with respect to which formats are selected for display. Bowman teaches formatting a spreadsheet-based scorecard in paragraphs 400-459. The scorecard is in spreadsheet format (paragraph 401), the cells can be linked to data (paragraph 407) and the risk values are linked by selecting a risk category and then choosing a particular risk from the category (paragraph 421). There are indicators and risk values used with the scoreboard (paragraph 447) as well as weighted average values and percentages (paragraph 453)). Bowman is an analogous art as it also teaches about risk assessment and management. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the risk assessment system of Schwartz with the scorecard feature of Bowman to provide a more user-friendly means of displaying the data.

14. Claims 3, 5, 8, 10, 14, 16, 19, 21, 25, 27, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (US 2003/0037063).

As per claims 3, 14 and 25, Schwartz teaches the maximum score is the same for each risk factor; and the importance value and maximum score for a risk factor remain constant across multiple projects. Official notice is taken that it is old and well known in the arts to have a range of values for rating risk factors, as noted in "The balanced scorecard: a foundation for the strategic management of information systems" by Martinsons et al. Decision Support Systems, 1999, pages 71-88. See page 78, second column, last paragraph, where the risk categories have a value rating from 0 to 5. The weighting is subjective to the user and the project, so if the importance or

weighting remains constant for each project that is deemed a design choice. The user has selected one risk factor as having consistent importance and risk for every project.

As per claims 5, 16 and 27, Schwartz teaches the components are collectively operable to generate a risk assessment for each risk factor category according to a category percentage risk for each risk factor category, the category percentage risk being determined by (paragraph 46): determining a quotient of a category actual score and a category maximum score (paragraph 50: "Variable values are then processed by a computer risk assessment application in the system to determine a composite risk score that indicates a level of risk present at the time the values were determined."), the category actual score reflecting the sum of the actual scores of all risk factors within a risk factor category, the category maximum score reflecting the sum of the maximum scores of all risk factors within a risk factor category; determining the quotient by dividing the category actual score by the category maximum score; and determining the category percentage risk by multiplying the quotient by one hundred. Official notice is taken that both the concept and advantage of mathematical manipulation are well known and expected in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to manipulate the data by adding, dividing and multiplying combinations of data to facilitate the analysis of the information.

As per claims 8, 19 and 30, Schwartz teaches the implementing entity is a seller of software to be implemented in the particular software implementation project at one or more sites of a client (paragraph 75: "Preferably, the risk assessment application is accessible by, or part of an overall system application that performs risk assessment,

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monitors risk, and assists workers in the field in managing primary client risk, thus forming a risk assessment, risk monitor, and case management system. This system application may be implemented by software on a computer. The risk assessment application of the present invention may be implemented with a software application or hardware that resides in the computer. Other data processing, data storage, and data retrieval of the system may be performed using the system software stored in the computer. The computer may be a server connected to a network with other devices capable running an Internet browser or other software that can be used to send, receive and display Web page information. These devices may include personal computers, portable computer devices, such as handheld or laptop computers, electronic paper, video monitors, audio systems, and wireless devices, such as wireless phones and PDA (Personal Data Assistant) devices. Other devices known to those skilled in the art are intended to be in the scope of the present invention." Official notice is taken that both the concept and advantage of having the seller install the software is well known and expected in the art. The software that is on the system would need to be installed by a person initially and it is known and common that the company that makes the software would send a sales representative to the site to install the software and set up the licenses on multiple site locations. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the seller to install the software to provide a more efficient means for initial set up of the system).

As per claims 10, 21 and 32, Schwartz teaches the relationship between the potential weighted score and the actual weighted score for each risk factor (paragraph

93: "Process 401 represents a step that may be included to initiate a risk assessment application when using ANN or AFLRA based applications. Input-output data sets of known risk assessment input and expected output are first obtained. This "historical" data is then stored in database 304 during process 402. The historical data set is used to train the ANN or AFLRA software in process 403 using error backpropagation or other training algorithms known to those skilled in the art. Of course, it is to be understood that steps 401-403 are not always necessary if a fuzzy logic expert system is used alone as the risk assessment application in the present invention." Whereby the algorithm relates between the historical or potential data and the actual data), determining assignment of the risk level for the risk factor (paragraph 101: "When a dangerously high-risk level is assessed for a primary client, system 300 may suggest other means of notification" whereby a flag may be generated as noted in paragraph 90 to indicate the level was exceeded.), is a percentage based on one minus the quotient of the actual weighted score and the potential weighted score for each risk factor. Official notice is taken that both the concept and advantage of calculating a risk factor utilizing the formula mentioned is well known and expected in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to calculate a risk factor this way to provide a means for weighting the risk and thus providing a more accurate score.

Allowable Subject Matter

15. Claims 6-7, 17-18 and 28-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following art also teaches about risk management: Ensing et al (US 2003/0009373), Innes et al (US 2002/0198750), Fogel et al (US 6,957,227), Fogel et al (US 5,542,905), Heinrich (US 2005/0114186), Khayat et al (US 6,327,571), Beaven et al (US 2004/0186762), PCT/US00/13201, "The balanced scorecard: a foundation for the strategic management of information systems" by Martinsons et al. Decision Support Systems, 1999, pages 71-88; "Instinct and Value in IT Investment Decisions" by Bannister et al, Occasional Paper Series 1999; "Palisade" @Risk 4.0—New tools, new speed, tighter fit with Excel; Major upgrade in best-selling decision-support tool now shipping", M2 Presswire, May 17, 2000; "@ Risk arms Excel with risk analysis" by Hammond, InfoWorld, March 20, 2000; and webarchive of www.palisade.com (10 pages) from the year 2000, @Risk 4.0.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Krisciunas whose telephone number is 571-272-6931. The examiner can normally be reached on Monday through Friday, 6:30 am to 3:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LMK

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April 27, 2006


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